

REMARKS

There should be no confusion as to what claims are pending in this application. In their previous amendment, applicants explained to the examiner that he was examining the wrong set of claims, yet the examiner still made the last rejection final.

There is attached to this paper a copy of the Preliminary Amendment and Transmittal Letter filed with this national stage application. As previously explained, there was some error in the numbering of the claims on the "amended sheet." That error was corrected in the previous amendment. Those amendments were penciled-in on applicants' copy of the amended sheet at the time the previous amendment (dated November 20, 2000) was filed and were not part of the original claims presented with the Preliminary Amendment. The examiner has refused entry of applicants' previous amendments for some unknown reason and continued to examine the wrong set of claims. Applicants do not understand why the examiner did not contact the undersigned in an effort to clarify the misunderstanding prior to issuing a final office action.

In an effort to clear up any remaining confusion, applicants have canceled all of the claims presently in the application and have submitted new claims herewith.

In view of the above facts, it would be appropriate for the examiner to withdraw the final rejection, enter the present amendment of the claims, and examine the proper claims. There would not appear to be any other appropriate course of action.

When the examiner examines the claims properly of record, he is respectfully requested to consider the arguments presented in the previous amendment with respect to the rejections as they would or would not be applicable to the claims of record.

It should be emphasized that the claims require "at least one non-continuous hydrophobic coating." The references relied on by the examiner do not explicitly disclose that limitation. It should be noted particularly that all portions of the references referred to by the examiner refer to hydrophobic layers which appear to be themselves continuous. Hydrophilic zones are applied on top of the hydrophobic layer, but the hydrophobic layer itself is continuous.

It is possible that the examiner is reading the claims as being drawn to the broadest embodiments disclosed in the original specification. The claims now and the originally presented "amended sheet" claims are limited to a preferred embodiment disclosed at page 3, lines 27-32. The original claim used the term "non-continuous." In the descriptive part of the specification, the word "discontinuities" is used. The claim language can be appropriately amended or can be added by amendment to the descriptive portion of the specification if the examiner desires it. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).

In light of the above remarks it is respectfully requested that the examiner enter the previous amendments to the correct claims submitted with the Preliminary

Amendment, cancel the correctly amended original claims, enter the new claims and withdraw the final rejection and reconsider the patentability of the claims. It is respectfully submitted that the proper claims as amended and as resubmitted in clean copy herewith are patentable over the prior art relied on by the examiner and that this application should be passed to issue.

A check in the amount of \$110.00 is attached to cover the required one month extension fee.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF


Melvin Goldstein
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MG/kas

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Cancel all claims presently in the application, claims 1-12.

Add new claims 13-21 as follows:

– 13. (new) A solid support for analytical measurement methods which is essentially composed of an inert solid support material on which hydrophilic measurement zones are separated from one another by at least one non-continuous hydrophobic coating, where the number of measurement points applied per cm² of the support is greater than or equal to 10.

14. (new) A solid support as claimed in claim 13, wherein the hydrophilic measurement zones applied to the support are separated from one another by non-continuous hydrophobic zones in the forms of rings.

15. (new) A support as claimed in claim 13, wherein the support material used is glass, ceramic, quartz, metal, stone, plastic, rubber, silicon or porcelain.

16. (new) A support as claimed in claim 13, wherein a transparent support material selected from the group consisting of glass, quartz, silicon, or plastic is used.

17. (new) An analytical measurement method which comprises applying liquid analysis samples in the hydrophilic measurement zones of a support as claimed in claim 13, overlaying the hydrophilic measurement zones with a hydrophobic liquid and performing the analysis.

18. (new) A analytical measurement method as claimed in claim 17, wherein the

analytical measurement is carried out in an atmosphere which is virtually saturated with water vapor.

19. (new) An analytical measurement method as claimed in claim 17, wherein the analytical measurement is carried out while cooling the support.

20. (new) The analytical measurement method of claim 17 adapted for diagnostic methods, screening of active substances, combinatorial chemistry, crop protection, toxicology or environmental protection.

21. (new) A solid support as claimed in claim 13, wherein an additional surface loading is applied to the hydrophilic measurement zones.--

U.S. PATENT AND TRADEMARK OFFICE
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
JUN 12 2001
1700 MAIL ROOM
For: SOLID SUPPORTS FOR ANALYTICAL MEASURING PROCESSES, A PROCESS
FOR THEIR PREPARATION, AND THEIR USE

In re the Application of)
EIPERL et al.)
International Application)
PCT/EP 97/03571)
Filed: July 7, 1997)
)

PRELIMINARY AMENDMENT

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Prior to examination, kindly amend the above-identified application as follows.

IN THE CLAIMS

Page 11 of the claims, indicated line 35, replace "11.
[sic]" with --7.--;

indicated line 39, replace "12.[sic]"
with --8--.

Claim 3, line 1, delete "or 2" and insert --claim 1--.

Claim 4, line 1, delete "any of claims 1 to 3" and insert
--claim 1--.

Claim 5, line 1, delete "any of claims 1 to 4" and insert
--claim 1--.

Newly renumbered claim 7, lines 1 and 2, delete "or 6".

Newly renumber claim 8, line 1, delete "any of claims 1 to 4" and insert --claim 1--.

REMARKS

Claims 1-12 were amended in the international preliminary examination. An English language translation of the amended claims is attached. The claims were incorrectly numbered in the

amendment, and the instant preliminary amendment corrects the misnumbering. The claims have been further amended to eliminate multiple dependency and to put them in better form for U.S. filing. No new matter is included.

Favorable action is solicited.

Respectfully submitted,

KEIL & WEINKAUF

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We claim:

1. A solid support for analytical measurement methods which is
5 essentially composed of an inert solid support material on
which hydrophilic measurement zones which may be provided
with a surface loading are separated from one another by at
least one non-continuous hydrophobic coating, where the
number of measurement points applied per cm² of the support
10 is greater than or equal to 10.
2. A solid support as claimed in claim 1, wherein the hydro-
philic measurement zones applied to the support are separated
from one another by non-continuous hydrophobic zones in the
15 form of rings.
3. A support as claimed in claim 1 ~~or 2~~, wherein the support ma-
terial used is glass, ceramic, quartz, metal, stone, plastic,
rubber, silicon or porcelain.
20
4. A support as claimed in any of claims 1 to 3, wherein a
transparent support material selected from the group of
glass, quartz, silicon or plastic is used.
- 25 5. An analytical measurement method which comprises applying
liquid analysis samples in the hydrophilic measurement zones
of a support as claimed in any of claims 1 to 4, overlaying
the hydrophilic measurement zones with a hydrophobic liquid
and performing the analysis.
30
6. An analytical measurement method as claimed in claim 5,
wherein the analytical measurement is carried out in an at-
mosphere which is virtually saturated with water vapor.
- 35 7. ~~[sic]~~ An analytical measurement method as claimed in claim 5
or 6, wherein the analytical measurement is carried out while
cooling the support.
8. The analytical measurement method of claim 5
adapted for
12. ~~[sic]~~ [The use of a support as claimed in any of claims 1 to 4]
40 [in] diagnostic methods, [in] Screening of active sub-
stances, [in] combinatorial chemistry, [in] crop protection, [in]
toxicology or [in] environmental protection.



TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A FILING UNDER 35 U.S.C. 371

ATTORNEY'S DOCKET NUMBER 47114

U.S. APPLICATION NO. (If known, see 37 CFR 1.5)

INTERNATIONAL APPLICATION NO. PCT/EP 97/03571 INTERNATIONAL FILING DATE 7 July 1997 PRIORITY DATE CLAIMED 18 July 1996

TITLE OF INVENTION: SOLID SUPPORTS FOR ANALYTICAL MEASURING PROCESSES, A PROCESS FOR THEIR
PREPARATION, AND THEIR USE

APPLICANT(S) FOR DO/EO/US Heinz EIPEL, Harald KELLER

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. This is a FIRST submission of items concerning a filing under 35 U.S.C. 371.
2. This is a SECOND or SUBSEQUENT submission of items concerning a filing under 35 U.S.C. 371.
3. This express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4. A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. A copy of the International Application as filed (35 U.S.C. 371(c)(2)).
 - a. is transmitted herewith (required only if not transmitted by the International Bureau).
 - b. has been transmitted by the International Bureau.
 - c. is not required, as the application was filed in the United States Receiving Office (RO/USO).
6. A translation of the International Application into English (35 U.S.C. 371(c)(2)).
7. Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)).
 - a. are transmitted herewith (required only if not transmitted by the International Bureau).
 - b. have been transmitted by the International Bureau.
 - c. have not been made; however, the time limit for making such amendments has NOT expired.
 - d. have not been made and will not be made.
8. A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. An oath or declaration of the inventor(s) (35 U.S.C. 171(c)(4)).
10. A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11. to 16. below concern other document(s) or information included:

11. An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. A FIRST preliminary amendment.
 A SECOND or SUBSEQUENT preliminary amendment.
14. A substitute specification.
15. A change of power of attorney and/or address letter.
16. Other items or information.
International Search Report
International Preliminary Examination Report



| | | |
|--|--------------------------|-----------------------|
| U.S. Appl. No. (If Known) | INTERNATIONAL APPLN. NO. | ATTORNEY'S DOCKET NO. |
| PCT/EP 97/03571 | | 47114 |
| 17. /X/ The following fees are submitted | | <u>CALCULATIONS</u> |
| | | <u>PTO USE ONLY</u> |
| BASIC NATIONAL FEE (37 CFR 1.492(a)(1)-(5)): | | |
| Search Report has been prepared by the | | |
| EPO or JPO..... \$840.00 840.00 | | |
| International preliminary examination fee paid to USPTO (37 CFR 1.482)..... \$750.00 | | |
| No international preliminary examination fee paid to USPTO (37 CFR 1.482) but international search fee paid to USPTO (37 CFR 1.445(a)(2))..... \$700.00 | | |
| Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO \$970.00 | | |
| International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied pro visions of PCT Article 33(2)-(4)..... \$98.00 | | |
| ENTER APPROPRIATE BASIC FEE AMOUNT = \$ 840.00 | | |
| Surcharge of \$130.00 for furnishing the oath or declaration later than / / 20 / /30 months from the earliest claimed priority date (37 CFR 1.492(e)). | | |
| <u>Claims</u> | <u>Number Filed</u> | <u>Number Extra</u> |
| Total Claims | 8 -20 | X\$18. |
| | 1 | |
| Indep. Claims | -3 | X\$78. |
| Multiple dependent claim(s) (if applicable) | | +260. |
| TOTAL OF ABOVE CALCULATION | | = 840.00 |
| Reduction of 1/2 for filing by small entity, if applicable. Verified Small Entity statement must also be filed (Note 37 CFR 1.9, 1.27, 1.28). | | |
| SUBTOTAL = 840.00 | | |
| Processing fee of \$130. for furnishing the English translation later than / /20 / /30 months from the earliest claimed priority date (37 CFR 1.492(f)). + | | |
| TOTAL NATIONAL FEE | | = 840.00 |
| Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31) \$40.00 per property = 40.0 | | |
| TOTAL FEES ENCLOSED | | = \$ 880.00 |
| Amount to be refunded: \$ _____ | | |
| Charged \$ _____ | | |

a./X/ A check in the amount of \$ 880.00 to cover the above fees is enclosed.

b./ / Please charge my Deposit Account No. _____ in the amount of \$ _____ to cover the above fees. A duplicate copy of this sheet is enclosed.

c./X/ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 11-0345. A duplicate copy of this sheet is enclosed.

+
NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b) must be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO:
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JUN 14 2001
TC-1700 MAIL ROOM